UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHYAM S. BAYYA, GUILLERMO R. VILLALOBOS, JASBINDER S. SANGHERA and ISHWAR D. AGGARWAL

Appeal No. 2005-0630
Application No. 09/699,396

ON BRIEF

Before KIMLIN, HANLON and OWENS, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request reconsideration of our Decision on Appeal dated April 20, 2005, wherein this panel affirmed the following rejections:

(1) The rejection of claims 1, 3 and 13 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Petersen, Strom, Anderson and Okabe.

(2) The rejection of claims 3-8, 12 and 15-19 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Petersen, Strom, Anderson, Okabe and Masters.

(3) The rejection of claims 10 and 20 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Petersen, Strom, Anderson, Okabe, Masters, Hanneman and Chau.

(4) The rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Petersen, Strom, Anderson, Okabe, Masters, Hanneman, Chau and Ohoshi.

We have carefully reconsidered our decision in light of the arguments advanced in the request for rehearing, and we find no error therein. Therefore, we decline to make any changes in our prior decision for the reasons which follow.

I.

Appellants argue that it was error for this panel to equate gelation with precipitation in considering the teachings of Petersen and the rejections on appeal. See Decision on Appeal dated April 20, 2005, p. 5. In this regard, appellants argue for the first time on appeal that precipitation is not gelation. Appellants also rely on portions of two documents which were not previously relied on in the brief to support their argument. See Request for rehearing, pp. 1 and 3-4.

Significantly, 37 CFR § 41.52(a)(1) (2004) provides:

> Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section.

Paragraphs (a)(2) and (a)(3) of 37 CFR § 41.52 do not apply in this case. Therefore, according to 37 CFR § 41.52(a)(1), appellants' argument and the two documents relied on in support thereof are not entitled to consideration on rehearing.

We further note that in distinguishing the claimed process from the process disclosed in Petersen, appellants made the following statements in the brief on appeal (Brief, pp. 5-6):[1]

> A side-by-side comparative color chart of the Petersen reference method and the herein-claimed Naval Research Laboratory (NRL) method, given to the Examiner during the interview on July 30, 2002, and included herein, shows formation of the coating material on the particle after the spraying step in the NRL method and formation of the coating material on the particle prior to the spraying step, which difference results in unexpected advantages. Independent claims 1 and 13 were amended to focus on this difference by reciting that the precursor was not precipitated until after the spraying step.
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> Furthermore, it is believed that the Petersen reference leads away from the herein-claimed method by causing precipitation before the spraying step. [Emphasis added.]

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[1]As in the Decision on Appeal dated April 20, 2005, reference to the "Brief" is to the "Second Revised Appeal Brief" dated October 23, 2003.

II.

Appellants also argue that our decision is based on hindsight knowledge of the claimed subject matter because the rejections on appeal are based on at least four, and as many as eight, references. Request for rehearing, p. 3. Again, this argument was not raised in the brief before the Board. See 37 CFR § 41.52(a)(1)(2004). Suffice it to say that the criterion for obviousness under 35 U.S.C. § 103(a) is not the number of references applied in a rejection, but what those references would have meant to one of ordinary skill in the art. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

III.

Appellants' remaining arguments in the request for rehearing merely restate arguments previously made in their brief or indicate a disagreement with the panel's final decision on the merits. Appellants' request for rehearing is entitled to consideration only to the extent it specifies with particularity the points believed to have been misapprehended or overlooked in rendering the final decision. See 37 CFR § 41.52(a)(1) (2004). Thus, appellants may not use its request for rehearing as a vehicle to reargue matters that were considered in the final

decision or to express its disagreement with the decision on the merits.

IV.

For the reasons set forth above, appellants have failed to establish that this panel misapprehended or overlooked any points in rendering the Decision on Appeal dated April 20, 2005. Therefore, the request for rehearing is **DENIED**.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING - DENIED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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ADRIENE LEPIANE HANLON) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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TERRY J. OWENS)
Administrative Patent Judge)

ALH/hh

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